UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/970,409	10/03/2001	Matthew Shulman	213792	2545

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EXAMINER
DAM, TUAN QUANG

ART UNIT	PAPER NUMBER
2124	

DATE MAILED: 03/29/2002

#6

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 07-01)

Office Action Summary

Application No.	Applicant(s)
09/970,409	Shulman et al.
Examiner	Art Unit
Tuan Q. Dam	2124

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE ___3___ MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on _Oct 3, 2001 - Preliminary Amendment_

2a) ☐ This action is **FINAL.**   2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle,* 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) _21-24_ is/are pending in the applica

   4a) Of the above, claim(s) _____ is/are withdrawn from considera

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) _21-24_ is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claims _____ are subject to restriction and/or election requirem

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

11) ☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

   a)☐ All b) ☐ Some* c) ☐ None of:

   1. ☐ Certified copies of the priority documents have been received.

   2. ☐ Certified copies of the priority documents have been received in Application No. _____ .

   3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

   *See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

15) ☒ Notice of References Cited (PTO-892)

16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _2 & 5_

18) ☐ Interview Summary (PTO-413) Paper No(s). _____

19) ☐ Notice of Informal Patent Application (PTO-152)

20) ☐ Other:

DETAILED ACTION

1.   Claims 21-24 are presented for examination.

Double Patenting

2.   The non-statutory double patenting rejection, whether of the obviousness-type or

non-obviousness-type, is based on a judicially created doctrine grounded in public policy (a

policy reflected in the statute) so as to prevent the unjustified or improper timewise extension

of the "right to exclude" granted by a patent. *In re Thorington,* 418 F.2d 528, 163 USPQ 644

(CCPA 1969); *In re Vogel,* 422 F.2d 438, 164 USPQ 619 (CCPA 1970); *In re Van Ornum,*

686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Longi,* 759 F.2d 887, 225 USPQ 645 (Fed.

Cir. 1985); and *In re Goodman,* 29 USPQ2d 2010 (Fed. Cir. 1993).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(b) and (c) may be

used to overcome an actual or provisional rejection based on a non-statutory double patenting

ground provided the conflicting application or patent is shown to be commonly owned with

this application. See 37 CFR 1.78(d).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal

disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37

CFR 3.73(b).

3.   Claims **22** and **24** are rejected under the judicially created doctrine of obviousness-type

double patenting as being unpatentable over claims 1 & 29 of U.S. Patent No. **6,311,323**; and

Claim **21** is rejected under the judicially created doctrine of obviousness-type double patenting

as being unpatentable over claim 6 of U.S. Patent No. **6,026,233**. Although the conflicting

claims are not identical, they are not patentably distinct from each other because the claimed

subject matter contains obvious modifications to previous claims 1 & 29 of the patent

6,311,323 and previous claim 6 of the patent 6,026,233.

As to claim **22**, which includes limitations of *"modifying the present programming*

language statement...and automatically removing the passive assist window..." (Already

included in the patent '323, claim 1 at col. 19:50-55).

As to claim **24**, which includes limitations of *"receiving a user input selection...and*

adding the selected textual programmatic entity to the displayed statement" (Already included

in the patent '323, claim 29 at col. 23:40-43).

As to claim **21**, recites limitations which already included in claim 6 of the patent '233,

for example:

> *"enabling a programming language editor..."* (*See* claim 6 at col. 20:38-39*)*;

> *"partially compiling available...statements..."* (*See* claim 6 at col. 20:42-47*)*;

> *"defining a finite set of...statement...that is proximate to said character position..."*

(*See* claim 6 at col. 20:48-56*)*; and

> *"automatically generating a passive assist window..."* (*See* claim 6 at col. 20:57-58*)*.

It is well settled that the omission of element and its function (from claim 6 of the

patent '233) in combination is an obvious expedient if the remaining elements perform the

same functions as before. Elimination/Changing of an element or its function, alone, without

producing any new or unexpected result do not alone necessarily impart patentability. *In re*

KARLSON, 136 USPQ 184 (CCPA 1963). Also note *Ex parte Rainu*, 168 USPQ 375

(BdPatApp&Int 1970). Therefore, omitting various elements from the previous claimed

subject matter would have been obvious to one of ordinary skill in the art in this case since the

remaining elements do in fact perform the same functions as before.

Claim Rejections - 35 USC § 103

4.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> *(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.*

5.   Claims **21 - 24** are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith

'5,485,618' (art of record and hereinafter *Smith '618*).

As to claim **21**, *Smith '618* discloses a method, a development system having an

expression builder (*editor*) for assisting a user with creating an expression (*programming*

language statement) with immediate feedback, full syntax checking enabled, dynamically

adjusted during user editing (real-time), and the user is provided with in <u>situ assistance</u> in

constructing syntactically-correct expressions (*See* Abstract and col. 3:23 to col. 4:67). In

that, *Smith '618* also discloses means for storing (computer-readable medium) that cause a

computer system for creating/editing an expression by performing the steps of:

"*enabling a programming language editor...*" (E.g., see FIG. 2C and at col. 8:16-34);

"*partially compiling available ones of a plurality...statements*" (E.g., see FIG. 3A

Safety Net 302 feature, continuous syntax checking by the system, and at col. 10:1-16);

"*defining a finite set of...statement information that is relevant...*" (E.g., see FIGs. 3A

& 4A Category, Type, and Paste list boxes (windows) 306, 307, 308 and associated text, e.g.,

col. 8:58-59 states "As the user selects from each list, the list box to the right is updated to

show choices available in that group");

"*automatically generating a passive assist window that contains said finite set*

of...statement..." (E.g., again see FIGs. 3A & 4A list boxes/windows 306, 307 & 308 and

associated text as noted above).

Although *Smith '618* discloses the assist window but does not explicitly disclose the

position of the assist window that is "*in a location proximate to said character position*

cursor". However, *Smith '618* also discloses such features as "pulldown menu" as is known

in windowing applications art (*See* col. 7:4-7), and furthermore with such features for

invoking and/or displaying, pop-up/passive, edit box (window) by "click at or near" at such a

cursor position, <u>as needed</u> (*See* pop-up edit box/window in FIG. 3C edit box 322, FIG. 4C

edit box 432 & FIG. 4E box 451 and associated text at col. 10:45-54 & at col. 11:32-55,

respectively). Thus, it would become apparent to one skilled in the pertinent art at the time of

the invention was made to also recognize such known teachings in the windowing applications

art, pulldown menu and/or pop-up box/window effect, and would include and/or modifying it

(list boxes/windows 306, 307 & 308) into the *Smith '618* in such a location as claimed, as

needed to get the same as such a passive, pulldown and/or pop-up, box/window effect.

As to claim **22**, *Smith '618* also discloses "*modifying the present...statement based at*

least in part on the selected...statement information" (E.g., again see FIGs. 3A & 4A and

associated text as noted above); and "*automatically removing the...window when...statement has been amended*" (E.g., see FIGs. 4C & 4D and at col. 11:32-38, as pop-up edit box/window 432 is removed from FIG. 4D whereupon input is placed in the expression (*has been amended*)).

As to claim **23**, as set forth in claim 21 above, *Smith '618* also discloses:

"*automatically displaying the computer programming statement*" (E.g., again see FIG. 3A Result box 305 and associated text); and

"*proximate to the display of an incomplete...statement* (E.g., see FIG. 3A Expression window 301 and associated text), *automatically displaying a dynamic list of one or more textual programmatic entities*" (E.g., again see FIG. 3A Category, Type, and Paste list boxes 306, 307 and 308).

As to claim **24**, *Smith '618* also discloses such an editing means for "*receiving a user input selection...and adding the selected...*" (E.g., again see Expression Builder dialog 300 in FIGs. 3A & 4A and associated text as noted above).

Conclusion

6.   The background art of interest is cited by the examiner. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tuan Dam whose telephone number is (703) 305-4552. The examiner can normally be reached on Tuesday-Friday from 7:30 AM to 5:00 PM. The examiner can also be reached on alternate Mondays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Gregory Morse, can be reached on (703) 308-4789.

> **Any response to this action should be mailed to:**
> Commissioner of Patents and Trademarks
> Washington, D.C. 20231
> **or faxed to:**
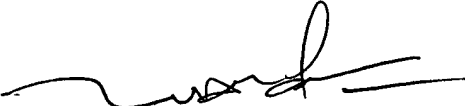> (703) 746-7239, (for formal communications intended for entry)
> **Or:**
> (703) 746-7240 (for informal or draft communications, please label
> "PROPOSED" or "DRAFT")
> Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive,
> Arlington. VA., 22202. Fourth Floor (Receptionist).

Any inquiry of a general nature or relating to the status of this application or

proceeding should be directed to the Group receptionist whose telephone number is (703) 305-

3900.

TQD
03/22/02

TUAN Q. DAM
PRIMARY EXAMINER